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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,048	08/26/2003	Hajime Akutsu	16869N-092000US	4974
20350 7590 12/05/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
KHAN, ASHER R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/649,048

Applicant(s)

AKUTSU ET AL.

Examiner

ASHER KHAN

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-9 and 13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3, 7-9 and 13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 8/1/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-3, 7-9 and 13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 7, 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0122950 A1 to "Anderson" in further view of U.S. Patent Pub. 2002/0021359 A1 to Okamoto.**

As Claim 1, 7 and 13, Anderson discloses an image data recording apparatus comprising:

an image signal processing module which converts an image signal to a digital image signal (Abstract; 0035; Optical Information is converted in digital information because of D/A);

a first image compressing module (Fig. 5, 622) which encodes said digital image signal to first image data according to a first recording format (High resolution version) (0040-0041);

a second image compressing module (Fig. 5, 614) which encodes said digital image signal to second image data (Medium resolution version) according to a second

recording format whose coding rate is lower than the coding rate of the first recording format (0040-0041);

a recording module which records image data on a recording medium (Fig. 5, 354);
a control module (Fig. 5, 618) which provides control so that said digital image signal converted by said image signal processing module is encoded, and said first image compressing module and said second image compressing module are controlled so as to generate said first image data and said second image data in parallel, and said second image is recorded on said recording medium (0042; Image by module 622 and 614 can be compressed along with each other i.e. in parallel; Anderson discloses first image is recorded on the recording medium instead of second but it would have been obvious to one with ordinary skill in the art to store second compressed image according to a choice of design).

Anderson does not expressly disclose a transmission module which transmits image data to an external apparatus and said first image data is transmitted to the external apparatus via the transmission module.

Okamoto discloses a transmission module which transmits image data to an external apparatus (Fig. 2, 60) and said first image data is transmitted to the external apparatus via the transmission module (0032;0041; Image is compressed and transmitted to the external apparatus).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Anderson with the teachings of Okamoto. Rationale to combine would have been that all the claimed elements were known in the prior art and one

skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 8, Okamoto further discloses wherein said first image data is recorded on said recording medium and then transmitted to the external apparatus and the recorded first image data is erased from said recording medium after the transmission is complete (0073).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Anderson with the teachings of Okamoto. Rationale to combine would have been that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0122950 A1 to "Anderson" in view of U.S. Patent Pub. 2002/0021359 A1 to Okamoto and in further view U.S. Patent Pub. 2002/0126999 A1 Shimamoto et al. ("Shimamoto").

As to claim 2, Okamoto discloses after said image data is recorded on said recording medium and then transmitted via said transmission module to the external apparatus (0032; 0041).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Anderson with the teachings of Okamoto. Rationale to combine

would have been that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Okamoto as discussed in claim 1 above does not expressly disclose wherein said control module provides further control so that if said recording medium has not a sufficient recording capacity, the recorded first image data is erased from said recording medium.

Shimamoto discloses wherein said control module provides further control so that if said recording medium does not have a sufficient recording capacity, the recorded first image data is erased from said recording medium (0109).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine Okamoto with Shimamoto. The Motivation to combine the two references would have been to erase previously recorded program to secure free space on a recording medium, to obtain sufficient recording area (Shimamoto, 0109)

5. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0122950 A1 to "Anderson" in view of U.S. Patent Pub. 2002/0021359 A1 to Okamoto and in further view U.S. Patent Pub. U.S. Patent Pub. 2002/0003578 A1 Koshiba et al. ("Koshiba")

As to claim 3, Okamoto discloses a display module which displays (Fig. 2, 16) images, and an image decoding means for decoding said second image data to an image signal which can be represented on said display means (Fig 2, 52).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Anderson with the teachings of Okamoto. Rationale to combine would have been that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Okamoto as discussed in claim 1 above does not expressly disclose wherein said control means provides further control so that if an operation is made to instruct replay, said second image data recorded on said recording medium is decoded by said image decoding means and images are displayed on said display means based on the decoded second image data.

Koshiba disclose wherein said control means provides further control so that if an operation is made to instruct replay, said second image data recorded on said recording medium is decoded by said image decoding means and images are displayed on said display means based on the decoded second image data (0099).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine Okamoto with Koshiba. The Motivation to combine the two references would have been to view the captured images on the screen (Koshiba, 0099).

As to claim 9, Koshiba further discloses wherein if an operation is made to instruct replay, second image data recorded on said recording medium is decoded and

images are displayed on a display module based on the decoded second image data (0099).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine Okamoto with Koshiba. The Motivation to combine the two references would have been to view the captured images on the screen (Koshiba, 0099).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621
/A. K./
Examiner, Art Unit 2621

